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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,631	10/27/2003	Kevin L. Corcoran	021919-001110US	6410
20350	7590	03/24/2006	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			BLAKE, CAROLYN T	
		ART UNIT	PAPER NUMBER	3724

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/695,631	CORCORAN ET AL.	
	Examiner	Art Unit	
	Carolyn T. Blake	3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 December 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-6, 12, 13, 21-24 and 27-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-6, 12, 13, 21-24 and 27-33 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 22 December 2005 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to applicant's amendment received on December 22, 2005.
2. The objection to the drawings is withdrawn in view of the amendment.
3. The text of those sections in Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

4. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Conner et al (967,882).

Regarding claim 1, Conner et al disclose a punch as claimed, including: a cutting component (5) that is configured to a shape, the cutting component having a cutting edge (including teeth 6) and an opposing edge (near lug 7) substantially opposite the cutting edge; a cutting component housing (3) that houses the cutting component (5), the cutting edge and at least a portion of the opposing edge of the cutting component (5) extending beyond the cutting component housing (3); and a handle component (1) extending from the cutting component housing (3) for positioning the punch, and the handle component (1) configured to maintain an approximate orientation of the cutting component (5) relative to the cutting medium.

Regarding claim 2, Conner et al disclose the cutting component is a die configured to a shape.

5. Claims 21 and 29, 30, 32, and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Patenaude (5,230,156).

Regarding claim 21, Patenaude discloses a punch assembly, comprising: a handle end (15) and an opposite punch holding end (11); the punch holding end (11) holding a punch die (18) that extends beyond a cutting side of the punch holding end (11); and the handle end (15) includes a sleeve (unnumbered) with the thickness of the sleeve being approximately equal to one-half of the distance that the punch die (18) extends from the cutting side of the punch holding end (11). See FIG 4.

Regarding claim 29, Patenaude discloses a punch assembly, comprising: a punch holding end (11) having a top side (14) and opposing cutting side (13); a punch die (18) positioned in the punch holding end (11) and having a cutting edge that extends beyond the cutting side of the punch holding end (11); and a handle (15) extending from the punch holding end and configured, at least in part, to limit a cutting depth of the punch die (18).

Regarding claim 30, Patenaude discloses a sleeve (unnumbered) covering at least a portion of the handle (15), and at least a portion of the sleeve configured to cooperate with the handle to limit the depth of the punch die (18).

Regarding claim 32, Patenaude discloses a side of the punch die opposite the cutting edge is configured to directly receive a cutting force.

Regarding claim 33, Patenaude discloses the handle (15) is configured to substantially maintain an orientation of the cutting die (18) relative to the cutting medium.

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6. Claims 29, and 31-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Russell et al (5,746,104).

Regarding claim 29, Russell et al disclose a punch assembly, comprising: a punch holding end (23, including fork of shank 29) having a top side (top surface in FIG 2) and opposing cutting side (bottom surface in FIG 2); a punch die (25) positioned in the punch holding end (23) and having a cutting edge that extends beyond the cutting side of the punch holding end (23); and a handle (29) extending from the punch holding end and configured, at least in part, to limit a cutting depth of the punch die (25).

Regarding claim 31, Russell et al disclose the punch die (25) extends beyond the top side of the punch holding end (23).

Regarding claim 32, Russell et al disclose a side of the punch die opposite the cutting edge is configured to directly receive a cutting force.

Regarding claim 33, Russell et al disclose the handle (29) is configured to substantially maintain an orientation of the cutting die (25) relative to the cutting medium.

Claim Rejections - 35 USC § 103

7. Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conner et al as applied to claims 1 and 2 above, and further in view of Smith (3,250,163). Conner et al fail to disclose the material and method of manufacturing the die. However, Smith discloses a die made from steel rule (34), wherein the steel rule (34) has a first end and a second end; the first end and the second end are aligned and secured by welding. The ends of the steel rule (34) are welded to a plate (36). See col.

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2, lines 48-50. Smith further discloses the advantages of using a steel rule die include low cost, high effectiveness, and longevity (col. 1, lines 12-15). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to manufacture the die of the Conner et al device from steel rule, as disclosed by Smith, because steel rule is inexpensive, effective, and long lasting.

8. Claims 12, 13, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conner et al as applied to claim 1 above, and further in view of Cogdill et al (5,433,005). Conner et al fail to disclose a grip comprising a material that absorbs shock. However, Cogdill et al disclose a tool wherein the tool handle component (22) includes a grip (4) that is mounted on the handle (22) and is manufactured from a material (rubber) that absorbs shock. This material choice makes the handle comfortable for the operator and resists slipping that could occur during use. In addition, this grip/sleeve would limit the depth of cut with the handle component because an operator would hold the sleeve-handle combination when using the device and creating a cut. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a grip that is inserted on the handle and is manufactured from a shock-absorbing material, as disclosed by Cogdill et al, on the Conner et al device for the purpose of operator comfort and sliding resistance.

9. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Patenaude as applied to claim 21 above, and further in view of Bourbeau (5,561,903). Patenaude fails to disclose indicia identifying the cutting side of the punch assembly. However, Bourbeau discloses a tool wherein the tool action is indicated by indicia (62).

The indicia allow the operator to use the proper side of the tool. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide indicia, as disclosed by Bourbeau, on the Patenaude device for the purpose of indicating the action side of the tool.

10. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Patenaude as applied to claim 21 above, and further in view of Smith (3,250,163). Patenaude fails to disclose the material and method of manufacturing the die. However, Smith discloses a die made from steel rule (34), wherein the steel rule (34) has a first end and a second end; the first end and the second end are aligned and secured by welding. The ends of the steel rule (34) are welded to a plate (36). See col. 2, lines 48-50. Smith further discloses the advantages of using a steel rule die include low cost, high effectiveness, and longevity (col. 1, lines 12-15). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to manufacture the die of the Patenaude device from steel rule, as disclosed by Smith, because steel rule is inexpensive, effective, and long lasting.

11. Claims 24, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conner et al in view of Olson et al (2,611,757).

Regarding claim 24, Conner et al disclose a punch assembly substantially as claimed, including: a cutting component (5) that is configured to a shape; a cutting component housing (3) that houses the cutting component (5), the cutting component (5) extending beyond the cutting component housing (3); a handle component (1) extending from the cutting component housing (3) for positioning the punch, and the

handle component (1) configured to maintain an approximate orientation of the cutting component (5) relative to a cutting medium. Conner et al fail to disclose a cutting pad. However, disclose a cutting pad capable of being used with a device such as the Conner et al punch. The cutting pad provides a surface that is sufficiently hard so as to protect the surface beneath it and support the punch, but soft enough to allow the cutting edge to pass through the work piece. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a cutting pad, as taught by Olson et al, with the Conner et al punch for the purpose of simultaneously cutting through and supporting a work piece.

Regarding claims 26 and 27, the Conner et al cutting component (5) is configured to allow a force or hammer to apply a cutting force to the cutting component.

Response to Arguments

12. Applicant's arguments filed December 11, 2005 have been fully considered but they are not persuasive.

Applicant's arguments with respect to claims 1-6, 12, 13, 24, and 26-28 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues claim 29 is patentable because the prior art cited fails to show "a handle extending from the punch holding end and configured, at least in part, to limit a cutting depth of the punch die" (lines 5 and 6). However, this limitation can be read very broadly. As an operator holds the handle, the operator can limit the cutting depth of the punch die. Thus, the handle limits the depth die. As such, the prior art cited anticipates the claim. While Applicant may or may not intend for this limitation to have

an alternative interpretation, the current claim language can be interpreted as described above.

Applicant argues Patenaude discloses a cooking utensil, and therefore cannot anticipate the claims. However, there is nothing that prohibits the Patenaude device from being used as a punch. The device can be manufactured from metal and has a sufficiently sharp bottom edge capable of punching through a soft material, such as paper. Therefore, the Patenaude device can be considered a punch.

While differences may exist between Applicant's invention and the prior art of record, these differences have not been claimed.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn T. Blake whose telephone number is (571) 272-4503. The examiner can normally be reached on Monday to Friday, 8:00 AM to 5:30 PM, alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on (571) 272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CB
March 16, 2006


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